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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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KATTEN MUCHIN ROSENMAN LLP			WIN, AUNG T	
575 MADISON AVENUE			ART UNIT	
NEW YORK, NY 10022-2585			PAPER NUMBER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/771,704

Applicant(s)

USHIKI ET AL.

Examiner

Aung T. Win

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 28 & 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 28 recites the limitation "a content sending server sending out **the content**" in Line 7, Page 71. There is insufficient antecedent basis for this limitation in the claim.

Claim 30 recites the limitation "the held user identification information" in Line 1, Page 72. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 7, 8, 12, 13, 16-22, 24-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Chan et al. (US20040203638A1).

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2.1 Regarding Claim 1, Chan discloses a messaging system [Figure 1: 0018-0021] comprising:

A terminal sending a user identification information of a user using the terminal [Terminal with Token reader i.e., RFID tag reader: 0008, 0022, 0025] [Handheld Terminal: 0047 & 0048]; and

A messaging server holding content which corresponds to the user identification information of the user [Personalized Email message from Email server: 0026, 0027 & 0034], and

Delivering the content on a receipt of the user identification information sent from the terminal [Personalized data such as email message: Summary, 0026, 0027 & 0034] [Also see other personalized data: 0019].

2.2 Claim 25 is rejected for the same reason as stated above in Claim 1 rejection [See Claim 1 rejection]. The messaging server as stated above in Claim 1 rejection must comprise claimed memory unit to store user content i.e., user email based on received user id and claimed delivery unit to deliver stored content email as claimed.

2.3 Claim 26 is rejected for the same reason as stated above in Claim 1 rejection [See Claim 1 rejection]. The terminal used by user as stated above in Claim 1 rejection must comprise a transmission unit which transmits user identification information of the user using the terminal to a messaging server which delivers a content; a reception unit which receives from the messaging server the content corresponding to user

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identification information sent from the transmission unit; and a processing unit which executes processes, including display, audio output or storage, for the content received by the reception unit.

2.4 Claim 27 is also rejected for the same reason as stated above in Claim 1 rejection [See Claim 1 rejection]. The terminal used by user as stated above in Claim 1 rejection comprises RF-ID tag reader as claimed which wirelessly communicates with a wireless tag storing user identification information in advance, and reads the user identification information stored in the wireless tag, wherein the transmission unit transmits user identification information read by the read unit.

2.5 Regarding Claim 2, Chan also discloses that the system wirelessly communicate with user RFID tag comprising stored user id [0008, 0022 & 0027] and the terminal reads the user identification information from the wireless tag and sends the read user identification information to the messaging server [Terminal with Token reader i.e., RFID tag reader: 0008, 0022, 0025] [Handheld Terminal: 0047 & 0048] [Messaging server: A server computer integrated with email server or other data content server].

2.6 Regarding Claim 7, Chan also discloses passive RF Tag, which can only be powered by RF tag reader [0022].

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2.7 Regarding Claim 8, Chan discloses that RF tag and RF tag reader are operating in predetermined range [See Figure 3].

2.8 Regarding Claims 12 & 13, Chan discloses that information provided to user is based on read user tag ID and terminal ID in which user is using [context data or terminal ID: 0008, 0025-0030].

2.9 Regarding Claim 16, Chan discloses providing information stored in the content server i.e., email server or corresponding message server [0033 & 0034].

2.10 Claims 17, 18, 19 & 20 are rejected for the same reason as stated above in Claim 16. Chan messaging system must have claimed limitations because Chan discloses providing messaging services based such as scheduled service [0031 & 0032] and news service [0037 & 0038].

2.11 Claims 21 & 22 are also rejected for the same reason as stated above in Claim 1 rejection. Chan messaging system must have claimed limitations because Chan messaging system provides personalized information based on specific user preferences [0038] and Chan messaging system provide information to multiple users [0027].

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2.17 Claim 24 is rejected for the same reason as stated above in Claim 1 rejection.

Chan discloses that user terminal and messaging server are communicating via service manager 12 i.e., server computer 80 [Figures 1, 4 & 5] [0046] (claimed management server) wherein messaging server is integrated with user profiles database 36 for accessing user mail server (claimed messaging server).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3, 4 rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al. (US20040203638A1) in view of Fukuda (US20020116268A1).

3.1 Regarding Claim 3, Chan discloses all the limitations as stated above in Claim 1 rejection. Chan fails to disclose storing messaging server identification information in addition to the user identification information.

Fukuda discloses information providing system comprising RF-ID tag storing address of the network server that is to be accessed, RF-ID reader implemented in the portable terminal reading the stored address of the network server from RF-ID tag to

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further access the information from the network server [Summary] [RFID system: 0035-0037] [portable terminal: 0038-0043 & 0052-0082] [RF-ID Tag: 0044-0051]. Fukuda also teaches storing email address in the RF-ID tag for accessing mail server via the portable terminal [0103-0114] [Figures 1-6].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention of made to modify Chan's messaging system to install messaging server address information in the RF-ID tag as taught by Fukuda to process as claimed. One of ordinary skill in the art would have been motivated to do this to provide improved messaging system for user convenience [Fukuda: 0113]

3.2 Claim 4 is also rejected for the same reason as stated above in Claim 3 rejection. Fukuda teaches reading the stored information from the RF-ID tag by user [setting portable information terminal to information receive entry mode: 0065-0074].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention of made to further modify Chen's handheld terminal implemented with RF-ID tag reader as stated above for receiving RF-ID tag information based on user action as taught by Fukuda to modify as claimed. One of ordinary skill in the art would have been motivated to do this to provide improved user interface for user convenience.

4. Claims 5, 6, 9, 10, 11 & 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al. (US20040203638A1) in view of Gruteser et al. (US20030037243A1).

4.1 Regarding Claims 5, Chan teaches RF-ID tag reader reading the user ID from the RF-ID tag. Chan does not explicitly disclose reading the user ID periodically. Gruteser discloses RF-ID reader reading the identification information from RF-ID tag periodically and further updating the read information [0039]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention of made to modify Chan's RF-ID tag reader to read identification information from tag periodically as taught by Gruteser to modify and program RF-ID reader as claimed. One of ordinary skill in the art would have been motivated to do this to implement improved system so that providing wrong information to specific user can be avoided.

4.2 Claims 6, 9, 10, 11 & 14 are rejected for the same reason as stated above in Claim 5 rejection. At the time of invention of made, it is obvious to skill in the art that RF-ID readers can be programmed to utilize according to various applications as needed; moreover such claimed features are expected in the RF-ID reading applications. One of ordinary skill in the art would have been motivated to do modify as claimed to ensure the system with improved security and accuracy.

5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al. (US20040203638A1).

5.1 Regarding Claim 15, Official Notice is taken that Chan's terminal does not explicitly disclose format conversion as claimed. Official Notice is taken that concept

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and advantages of such claimed feature is well-known to one skill in the art at the time of invention of made in order to provide formatted version according to user terminal capability. Therefore, claimed feature is obvious to one skill in the art at the time of invention of made and it is also expected in the data transmission art. Therefore reformatting as claimed do not constitute a patentably distinct limitation.

6. Claims 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al. (US20040203638A1) in view of Katagishi et al. (US20030120745A1).

6.1 Regarding Claim 23, Chan discloses providing subscribed messaging services [0027] but does not explicitly disclose charging the user for provided information based on the delivery count.

Katagishi discloses information providing system and the method comprising tracking access count per user [0076]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention of made to modify Chan's messaging server to implement user access count tracking feature as taught by Katagishi to modify as claimed. One of ordinary skill in the art would have been motivated to do this provide improved information providing system for service provider.

7. Claims 28-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al. (US20040203638A1) in view of admitted prior art [0006].

7.1 Regarding Claim 28, Chan discloses a messaging system [Figure 1: 0018-0021] comprising:

A terminal sending a user identification information of a user using the terminal [Terminal with Token reader i.e., RFID tag reader: 0008, 0022, 0025] [Handheld Terminal: 0047 & 0048]; and

A service manager 80 integrated with user profile database 36 (claimed home agent server) wherein user terminal and messaging server are communicating via service manager 12 i.e., server computer 80 [Figures 1, 4 & 5] [0046] (claimed management server);

A messaging server holding content which corresponds to the user identification information of the user [Personalized Email message from Email server: 0026, 0027 & 0034], and

Delivering the content on a receipt of the user identification information sent from the terminal [Personalized data such as email message: Summary, 0026, 0027 & 0034] [Also see other personalized data: 0019].

Chan does not explicitly teach a home agent address management server although Chan teaches that the terminals comprises mobile client terminals [0047] for wireless communication. Chan also discloses admitted prior art wherein the prior art teaches receiving Web URLs for further requesting the content information [0006] based on received Web URLs. Therefore, it is obvious to skill in the art that Web URLs must have been stored in the network device in order to retrieve and transmitting to the user terminal.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention of made to modify Chan personalized messaging system to access requested information based on received content address as claimed. One of ordinary skill in the art would have been motivated to do this to provide improved distributed information storage and delivery system.

7.2 Claim 35 is rejected for the same reason as stated above in Claim 28 rejection.

It is obvious that modified terminal comprises processors integrated with first transmission unit and first reception unit for transmitting User ID and receiving Web URL as stated above in Claim 28; and second transmission unit and second reception unit for accessing content based on Web URL.

7.3 Claims 37-39 are also rejected for the same reason as stated above in Claim 28 rejection. At the time of invention of made, it is obvious to one skill in the art that modified system would have taught claimed content sending server and home agent server because modified system teaches mobile terminal configured to request web content wirelessly based on user identification information. Therefore, it is obvious to one skill in the art that such claimed sending server and home agent server are expected in the modified system for requesting content wirelessly.

7.4 Claim 29 & 36 are rejected for the same reason as stated above in Claim 28 and 35 rejections. Chan discloses a RF_ID tag and terminal integrated with RF_ID tag

reader as stated above in Claim 28 rejection therefore, modified system would have comprised of reading and sending steps as claimed.

7.5 Regarding Claims 30-34, modified terminal is capable of accessing information by browsing or accessing wirelessly based on received URLs as stated above. It is obvious to one skill in the art at the time of invention of made that modified system would have comprises claimed steps as stated in Claims 30-34 because modified terminal is configured to access or browse the requested information based on received URLs.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Prentice et al. (US20030110267A1)

Vanska et al. (US200400100446A1)

O'Rourke et al. (US20050188065A1)

Borella (US20030229697A1)

Rankin (US20030100315A1)

Perttila et al. (US20040087273A1)

Becker et al. (US20040046642A1)

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aung T. Win whose telephone number is (571) 272-7549. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on (571) 272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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November 27, 2006


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